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PATENT & TRADEMARK OFFICE

Applic

Applicant : Terrance W. Oliver

Group Art Unit: 3711

Appl. No. : 10/751,614

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Filed : January 5, 2004

For : INTELLIGENT CASINO CHIP

November 20, 2006

Examiner : Daniel A. Hess

Chad W. Miller, Reg. No. 44,943

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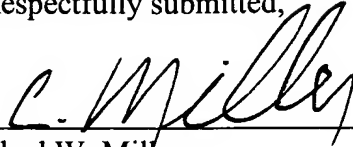
Transmitted herewith in triplicate is Appellant's Reply to the Examiner's Answer in this application, with respect to the Notice of Appeal filed on: March 31, 2006

No fee for filing this Response is believed due however, **the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No.: 502200. A duplicate copy of this sheet is enclosed.**

Appl. No. : 10/751,614
Filed : January 5, 2004

Dated: 11/20/06

Respectfully submitted,

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant : Terrance W. Oliver)
Appl. No. : 10/751,614)
Filed : January 5, 2004)
For : INTELLIGENT CASINO CHIP)
Examiner : Daniel A. Hess)

Group Art Unit: 2876

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(Date)

Chad W. Miller, Reg. No. 44,943

REPLY BRIEF TO EXAMINER'S ANSWER

I. INTRODUCTION

In this Reply Brief, Appellant's discussion focuses on rebuttal of Examiner's arguments presented in the Examiner's Answer. The Appellant submits that the Examiner is introducing new arguments and is not acknowledging or is improperly minimizing limitations in the claims. The limitations found in the claims are not found in the prior art.

Although this Reply Brief focuses primarily on the topics about which confusion could result from the Examiner's Answer, the Appellant disagrees with numerous aspects of the Examiner's position. The Appellant's decision to not address herein every point of disagreement should not be interpreted as agreement with the Examiner's position.

II. REPLY ARGUMENTS

1. The Examiner is Improperly Introducing New Arguments

At the first paragraph of Page 8 of the Examiner's Answer, the Examiner is introducing or suggesting new interpretations of the prior art, which may confuse the Board. At page 8, the

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Examiner now suggests a new and alternative interpretation of the term "class of gaming chip" which the Examiner proposes makes Rendleman come 'much closer' to a §102 type reference. The Examiner now suggests that 'class of gaming chip' could be interpreted 'broadly' (page 8, paragraph 4, page 4, paragraph 5) as casino designation or some other definition.

The Appellant regrets that the Examiner introduces this confusion at this stage of the Appeal by calling into question the definition of the term 'class of gaming chip'. At all times during the prosecution of this case, this term has meant a promotional or side-bet, such as for example, a progressive type wager. For the Board to allow the Examiner to change the definition of terms at this state would be unfair.

The term 'class of gaming chip' should be assigned the same meaning as was assigned during prosecution by the Examiner. The Examiner has consistently admitted on the record that Rendleman fails to teach an electronic based gaming chip that is configured with a second class designation, where the second class is a promotional or side-bet class, such as for example, a progressive type wager.. See:

1st Office Action, mailed 09/22/04, page 3, paragraph 1;

2nd Office Action, mailed 03/11/05, page 3, paragraph 6; and

3rd Office Action, mailed 11/02/05, page 5, paragraph 1.

2. The Examiner Improperly Characterizes Claim Limitations as Meaningless Intended Use Limitations

At page 9 of the Examiner's Answer, the Examiner improperly characterizes certain claim limitations as meaningless intended use type limitations. In this regard, the Examiner

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continues to discount or ignore valid claim limitations and improperly characterized these limitations as intended use limitations. Moreover, the Examiner cites only a limited passage of text from the claims for support of his argument, which may in turn lead to confusion by the Board.

Claim 21

The Appellant again submits that Claim 21 requires that the gaming chip have at least:

a data field in said memory, wherein an identification identifying a first class for the gaming chip is located in the data field;

This is a structural limitation which is not taught by the prior art. No prior art reference cited by the Examiner has memory with a data field *configured to store class information*. This is not an intended use limitation as it has nothing to do with use of the gaming chip, only the configuration of the gaming chip. Rendleman does not teach a gaming chip with a memory configured to identify a first class of gaming chip. Busch does not teach a gaming chip with a memory configured to identify a first class of gaming chip.

Claim 27

The Appellant again submits that Claim 27 requires that the gaming chip have:

at least one gaming chip of a second class having a second transponder containing at least value and class information, . . . ;

This is a structural limitation which is not taught by the prior art. No prior art reference cited by the Examiner teaches a transponder having *value and class information stored therein*. This is

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not an intended use limitation as it has nothing to do with use of the gaming chip, only the configuration of the gaming chip.

Claim 28

The Appellant again submits that Claim 28 requires that the gaming chip have:

at least one gaming chip of a first class in said betting area having a first transponder containing at least value information;

at least one gaming chip of a second class in said betting area having a second transponder containing at least value and class information;

This is a structural limitation which is not taught by the prior art. No prior art reference cited by the Examiner teaches a gaming chip with a *transponder containing value and class information*. This is not an intended use limitation as it has nothing to do with use of the gaming chip, only the configuration of the gaming chip.

Claim 36

The Appellant again submits that Claim 36 requires that the gaming chip have:

Promotional information encoded into the memory;

This is a structural limitation which is not taught by the prior art. No prior art reference cited by the Examiner teaches a gaming chip with promotional information encoded into the memory. This is not an intended use limitation as it has nothing to do with use of the gaming chip, only the configuration of the gaming chip, namely, the configuration of the encoded memory.

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In summary, the Appellant submits that the Examiner's argument that the claims rely on intended use limitation is at best a red-herring which will only confuse or mislead the Board. Indeed, the Examiner has previously admitted on the record that what is stored in memory is a real difference. See 3rd Office Action, mailed 11/02/05, page 3, second paragraph wherein the Examiner states:

As regards specific arguments by the applicant, the examiner agrees with the applicant that a difference in what is stored on the memory of a gaming chip is a real difference.

3. The Examiner is Misinterpreting or Misrepresenting the Teaching of Rendleman in Relation to Limitation of Claims

In the Examiner's Answer, the statements made the by Examiner suggest the following:

- A. The Examiner is mis-applying the test for obviousness.
- B. The Examiner is not giving full weight to all of the claim limitation;
- C. The Examine is expanding the teachings of Rendleman;

Each of these points is discussed below in greater detail.

A. The Examiner is mis-applying the test for obviousness

In the Examiner's Answer, the Examiner continues to reject the claims based on Rendleman, see Examiner's Answer, page 9, 2nd full paragraph, since Rendleman teaches storing value, or casino designation in the chips memory. The Examiner seems to argue that because

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Rendleman teaches chips which are capable of responding to transponder signals or because the Rendleman chips may contain a casino designation, all of the pending claims are obvious.

As such, it is clear that by continuing with this line of reasoning, the Examiner is not properly applying an element by element analysis of each claim limitation. A proper element by element limitation analysis is provided below.

B. The Examiner is not giving full weight to all of the claim limitation

As set forth above in Section 2, the Examiner is not giving full weight to all of the claim limitations. The claim limitations set forth above in Section 2 (in bold, italics) must be considered. These limitations require that the claims be limited to gaming chips that have transponder or memory structures that include class information. The Examiner continues to ignores or discount this structural limitation in his analysis. Limitations regarding the configuration or what is stored in memory are valid structural limitations. The Examiner admits this on page 3, 2nd full paragraph of the 3rd Office Action, but refuses to recognize these limitations in this case. See also In re Lawry, 32 F.3d 1579 (Fed. Cir. 1994) setting forth that memory configurations are valid claim limitations.

C. The Examiner is expanding the teachings of Rendleman

The fact of the matter is Rendleman does not teach a gaming chip configured to store class information as class information has been defined during prosecution, i.e. promotional or side bet, for example a progressive bet.

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If the chips of Rendleman were modified and reconfigured, then yes, they could contain class information, but as Rendleman currently reads, Rendleman does not teach a second class of chip and the Rendleman chips do not have memory or transponders which store a second class of chip information. The Examiner attempts to minimize the changes to Rendleman that would be required to have Rendleman mimic the present invention, but the Appellant submits that this is not relevant. It is not the size of the change, but the obviousness of the change that is at issue. Moreover, although something could be changed, does not make it obvious to make such a change. Again, Rendleman does not teach a memory or transponder in a gaming chip which stores class information.

Likewise, Busch only teaches different colored gaming chips for use in roulette or progressives, and as such, Busch does not teach a memory or transponder with class information stored therein. Indeed, the gaming chips of Busch do not even have memory.

III. NO SUGGESTION TO COMBINE AND IF COMBINED, ELEMENTS ARE MISSING

Since neither Rendleman nor Busch teach a memory or transponder with class information stored therein, even if these two references are combined, one would still not arrive at the claimed invention because the resulting combination would be missing a key element.

The Examiner argues that it would be obvious to modify Rendleman, but such modification would have to create a new element which is not taught by the prior art, namely, the element of a memory or transponder with class information stored therein. While it would be possible for an engineering team to make this modification, Appellant submits that this is not the

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test for obviousness. Examiner is over stretching the obviousness test to argue it would be obvious to create new elements which are not taught by the prior art.

In addition, and as discussed before in the Appeal Brief, the Appellant submits that neither Rendleman nor Busch contain a suggestion to combine. The Examiner relies on Busch for the suggestion to combine or modify, but, as stated before, Busch teaches the same old prior art configuration, i.e. using colored paint or colored dies to make colored chips (Busch at column 6, lines 40-43), and putting the gaming chips into separate betting location or into a slot (Busch at column 6, lines 35-40). In addition, the Busch reference expressly states the following at column 7, lines 9-11:

Since the colored chips used in the progressive jackpot game are the same as the chips a player uses during regular play, the dealer can immediately recognize and identify who is playing.

Because this passage teaches:

- 1) old-fashioned coloring of gaming chips,
- 2) using the same chips for the progressive as a player uses during regular play, and
- 3) having the dealer visually recognized the different chips,

it can hardly be argued that the inventor would have been lead down the path to modify Rendleman by adding new elements which are taught by neither Rendleman or Busch.

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IV. CONCLUSION

Neither Rendleman nor Busch alone or in combination, teach or suggest all of the limitations as recited in the claims on appeal. Appellant requests that the Board allow all pending claims.

Dated: _____

11/20/06

Respectfully submitted,

By: _____

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